

REMARKS

I. Status of the Claims

Claims 1-69 are pending in the application. Claims 2, 61, and 64 have been cancelled herein without prejudice or disclaimer. Applicants have added new claims 67, 68, and 69, which are dependent on claims 30, 16, and 63 respectively. These new claims are supported by the specification as filed.

Claims 1, 16, 27, 30, 32, 40, 45, 50, 63, and 66 have been amended herein to render them consistent with the respective claims in the parent application. Claim 23 has been amended to address the issue raised by the Office under 35 U.S.C. §112, second paragraph, in the parent application, by removing the phrase “optionally functionalized.” Accordingly, no new matter has been introduced by these amendments, nor do the amendments raise new issues or necessitate the undertaking of any additional search of the art by the Office.

The specification of the application has been amended to insert reference to the parent application of this Continuation Application and the French Priority Application from which benefit is claimed. No new matter has been introduced by this amendment.

Applicants gratefully acknowledge the withdrawal of the rejection of claims 16, 44, 60, 63, and 64 under 35 U.S.C. § 112, second paragraph, in the parent case.

Applicants also acknowledge that in the parent case the Office has entered Applicants' amendments to claims 1 and 12, removing the viscosity limitation, as set forth in Applicants' Amendments filed on June 5, 2002, and October 3, 2003,

respectively. However, Applicants note that the Office erroneously states on page 3 of the November 25, 2003, Office Action in the parent case, that the presently claimed invention relates to an emulsion having “a dynamic viscosity of 100 mPa.s-20 Pa.s.”

II. Rejection Under 35 U.S.C. § 112, Second Paragraph

In the parent case, the Office maintained its rejection of claim 23 under 35 U.S.C. § 112, second paragraph, as “indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.” (July 3, 2003, Office Action at p. 3.) The Office rejected claim 23 as indefinite for use of the term “functionalized,” alleging that “one of ordinary skill in the art would not be apprised of its meaning” (*id.* at p. 3), and because the definition provided by Applicants is “vague and indefinite.” (November 25, 2003, Office Action at p. 2.) Although Applicants continue to disagree that claim 23 is indefinite, at least for the reasons already of record in the parent case, Applicants have amended claim 23 without prejudice or disclaimer to remove the phrase “optionally functionalized,” solely in an effort to advance prosecution of this case.

III. Rejections Under 35 U.S.C. § 103(a)

A. European Patent No. 0 373 661 A2 in view of U.S. Patent No. 6,074,633

In the parent case, the Office rejected claims 1, 3-19, 23, 25-29, 40, 42-57, 59-60, 62-63, 65-66, and 68-69 under 35 U.S.C. § 103(a) as obvious over European Patent

No. 0 373 661 A2 ("EP '661") in view of U.S. Patent No. 6,074,633 ("633 patent").

(November 25, 2003, Office Action, pp. 3-6 and 8-9.) Applicants disagree with this rejection for the reasons already of record in the parent case and for those reasons stated below.

In the final Office Action issued November 25, 2003, in the parent case, the Office alleged that "[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the alpha, omega-substituted oxyalkylenated silicone of US '633 for the oxyalkylenated silicone of EP '661 because US '633 teaches these silicones as interchangeable emulsifiers . . . because of the expectation of achieving similar surfactant effects." (*Id.* at p. 5.) Applicants disagree.

Two of the basic criteria the Office must demonstrate in order to establish a *prima facie* case of obviousness are (1) that there is some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings, and (2) that there is a reasonable expectation of success in making the proposed modification. See M.P.E.P. § 2143.

Here, the Office's alleged evidence of a motivation to combine the teachings of the two references lacks the requisite specificity to justify a § 103(a) rejection. See *In re Dembicza*k, 175 F.3d 994, 999 (Fed. Cir. 1999) (requiring "clear and particular" evidence of a motivation to combine references). Specifically, in making the rejection, the Office has not demonstrated that the references, when considered as a whole,

suggest the desirability of making the proposed combination. When the Office considers the very specific teachings of each of EP '661 and the '633 patent, and in particular the conditions under which each reference discloses the use of oxyalkylenated silicones, it will be clear that there is no motivation to combine these references and no reasonable expectation of success in their combination.

EP '661, which is directed to a water-in-oil ("W/O") emulsion, does not teach or suggest substituting the silicone emulsifier disclosed therein with any silicone, let alone the specific α,ω -substituted oxyalkylenated silicones of the presently claimed invention. In fact, EP '661 discloses that it is "very difficult to obtain a highly stable water-in-oil type emulsion cosmetic which comprises a silicone oil as a base." See p. 2, Ins. 27-29. Only by satisfying very specific conditions, including "the use of a specific emulsifier," are the EP '661 inventors able to achieve a stable W/O emulsion. See, e.g., p. 2, Ins. 38-43. Notably, the "specific emulsifier" disclosed by EP '661 is not simply an oxyalkylenated silicone, as suggested by the Office at page 3, line 15 of the Office Action in the parent case, but rather, is a mixture of several emulsifiers. These teachings of EP '661 would thus actually suggest to the skilled artisan that the conditions disclosed therein, including the use of the "specific emulsifier" mixture, must be satisfied or the stability achieved by the invention would be destroyed. Therefore, it would not have been obvious to substitute any oxyalkylenated silicones, let alone the α,ω -substituted oxyalkylenated silicones of the presently claimed invention, into the "specific emulsifier" mixture of EP '661, and one skilled in the art would certainly not have expected to be

successful achieving a stable W/O emulsion in doing so in light of the teachings of the reference.

Furthermore, rather than a W/O emulsion, as disclosed by EP '661, the '633 patent is directed to a detergent cosmetic composition which successfully maintains water insoluble active principles in suspension in an aqueous medium. See, e.g., col. 2, Ins. 3-15. In setting forth the difficulties of achieving such a composition, the '633 patent also discusses the goals of the invention disclosed therein, such as keeping water insoluble active principles in an aqueous-based suspension without affecting the foaming properties of the composition (col. 1, Ins. 33-39), while maintaining good washing properties and imparting softness, disentangling, and styling properties (col. 2, Ins. 35-37). Despite the known difficulties in achieving such a goal, the '633 inventors have found a way to do this by adding specific oxyalkylenated silicones into a specific mixture of at least one anionic surfactant, at least one non-ionic or amphoteric cosurfactant, and at least one electrolyte, wherein this specific combination of components renders specific properties to the composition. See col. 2, Ins. 3-15. It is clear from the reference that it is this specific combination of elements that achieves the various goals of the reference discussed above. Thus, even assuming for the sake of argument that the Office is correct that the '633 patent suggests that its α,ω -substituted oxyalkylenated silicones are interchangeable with other oxyalkylenated silicones, it can hardly be argued that the '633 patent is suggesting that such a substitution would be successful outside of the very specific combination and conditions set forth therein.

Even more so, the '633 patent disclosure does not suggest that such a substitution would be successful in a W/O emulsion, as compared to the aqueous dispersion disclosed in the '633 patent, let alone the specific W/O emulsion containing the specific mixture of emulsifiers as in EP '661.

Accordingly, in light of these specific teachings in both EP '661 and the '633 patent, directed to different oxyalkylenated silicones and their role in maintaining the delicate balance of the specific compositions therein (W/O emulsions and aqueous dispersions), there is neither motivation to substitute them nor any reasonable expectation in the success of such a substitution. Applicants therefore respectfully submit that the Office did not establish a *prima facie* case of obviousness over this combination of references in the parent case.

B. U.S. Patent No. 6,159,486

In the parent case, the Office also maintained its rejection of claims 1, 3-19, 23, 25-29, 40, 42-57, 59-60, 62-63, 65-66, and 68-69 under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 6,159,486 ('486 patent'). (November 25, 2003, final Office Action, pp. 6-8, in Application No. 09/277,226.) The Office alleged that it would be obvious to one of ordinary skill in the art to "exemplify" the "method of reducing transfer/migration of composition" as allegedly taught by the '486 patent wherein the emulsion comprises alpha-omega-substituted oxyalkylenated silicone. (*Id.* at p. 7.)

Although Applicants do not agree that the claims at issue are obvious over the '486 patent for the reasons already of record in the parent application, Applicants submit that the '486 patent is not available as prior art over the present application under 35 U.S.C. § 103(c). As the Office is aware, § 103(c) reads:

Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Section 103(c) applies to the present application because it was filed after November 29, 1999. Furthermore, the '486 patent and the present application were commonly assigned to L'Oréal S.A., as reflected by the assignment recorded at Reel 9234, Frame 0929 in Application No. 09/013,268, the application which matured into the '486 patent, and the June 21, 1999, Submission of Assignment in Application No. 09/277,226, the parent of the present application. Therefore, Applicants respectfully submit that under § 103(a), the reference is not available as prior art.

IV. Conclusion

Applicants respectfully request consideration of the foregoing amendments and remarks in this application and the timely allowance of the pending claims.

If the Examiner believes that a telephone call to Applicants' representative would facilitate prosecution of this application, she is invited to contact the undersigned at 202-408-4307.

Cont. of Application No. 09/277,226
Attorney Docket No. 5725.0362-01

Please grant any extensions of time required to enter this paper and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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